

REMARKS

Claims 1-38 are pending in this application after this Amendment. Claims 1, 6, 19 and 36-38 are independent. In light of the amendments and remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claims 1, 3, 6, 8, 13, 19-21, 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Terashita (USP 5,369,463) (hereinafter Terashita '463) in view of Suzuki (Japanese Application Publication No. 09-116792) and further in view of Terashita (USP 4,769,695) (hereinafter Terashita '695); rejected claims 2, 7 and 24-27 under 35 U.S.C. § 103(a) as being unpatentable over Terashita '643 in view of Suzuki and Terashita '695 and further in view of Nishimura (USP 5,412,487); rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Terashita '463 in view of Suzuki and Terashita '695 and further in view of Maurinus (USP 6,222,646); rejected claims 5 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Terashita '643 in view of Suzuki and Terashita '695 and further in view of Zamir (USP 6,300,955); rejected claims 9 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Terashita '643 in view of Suzuki and Terashita '695 and further in view of Shiota (USP 6,011,547); rejected claims 10, 14-15 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Terashita '643 in view of Suzuki

and Terashita '695 and further in view of Hirose (USP 5,838,371) and Nishimura; rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Terashita '643 in view of Suzuki and Terashita '695 and further in view of Zamir and Nishimura; rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Terashita '643 in view of Suzuki and Terashita '695 and further in view of Shiota, Hirose, and Nishimura; and rejected claims 22-23 under 35 U.S.C. § 103(a) as being unpatentable over Terashita '643 in view of Suzuki and Terashita '695 and further in view of Yamamoto (USP 6,040,825). Applicants respectfully traverse these rejections.

Applicants wish to thank the Examiner for indicating claims 30-33 include allowable subject matter.

***Claim Rejections - 35 U.S.C. § 103 -  
Terashita '643/Suzuki/Terashita '695***

In support of the Examiner's rejection of claim 1, the Examiner asserts that Terashita '463 discloses the imaging part and the principle subject position recorder of the present invention. The Examiner admits that Terashita '463 is silent with regard to teaching or suggesting a display and a touch panel. The Examiner relies on the teachings of Suzuki to cure the deficiencies of the teachings of Terashita '463. The Examiner further admits that Terashita '463 and Suzuki do not teach or suggest finding a principle subject in accordance with a determined attached portion.

The Examiner relies on the teachings of Terashita '695 to cure the deficiencies of Terashita '463 and Suzuki and concludes one of ordinary skill would have been motivated to combine the teachings of these three references because a more precise area may be defined by the user. Applicants respectfully submit that these teachings are insufficient to establish *prima facie* obviousness under 35 U.S.C. § 103.

The disclosure of Terashita '463 is directed to an apparatus for recording position information of principle image and method of detecting principle image. In portions of the citations referred to by the Examiner, Terashita '463 discloses automatic detection of a principle subject performed by autofocus control circuit 100.

The disclosure of Suzuki is directed to an image pickup device that includes a touch panel 7 that enables a user to identify a field in the image to perform a zoom operation.

Finally, the disclosure of Terashita '695 is directed to a method of detecting principle subject images and determining exposures in color printing. Figure 1 discloses a schematic view of a color printer. Figure 8 discloses a touch panel sensor 80 which allows a user to specify a particular part of the color negative by touching it by means of a finger with the result that several picture elements will be included within the touched part.

Applicants respectfully submit that the teachings of Terashita '695 are insufficient to cure the deficiencies of the teachings of

Terashita '643. The teachings the Examiner is relying upon in Terashita '695 provide for determining a principal subject at the time of printing. However, claim 1 recites, *inter alia*, a principal subject determining device for determining a principal subject in the captured image shown on the display part in accordance with the determined touched portion; and a principal subject position recorder for recording, on the recording medium, principal subject positional information representing the position of the determined principal subject in the captured image when the captured image is recorded on the recording medium in accordance with the instruction from the recording instruction device, wherein a still image is recorded on the recording medium, with the positional information of the principal subject, after the principal subject is determined. As the Examiner's relied upon teachings of Terashita '695 disclose determining the principal subject at the time of printing, Applicants respectfully submit that these teaching are insufficient to cure the teachings of the primary reference.

Further, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to combine the teachings of Terashita '695, namely, touch panel sensor 80 of the color printer, with the teachings of Terashita '643, namely, automatic determining of the principle image for autofocus. As the system of Terashita '695, upon which the Examiner is relying,

teaches determining the principal subject during the printing operation, Applicants respectfully submit that one skilled in the art would not be motivated to make the purported combination. In support of his rejection of claim 1, the Examiner concludes that the motivation for combining these teachings is to provide a more precise area that may be defined by the user. However, this statement of motivation fails to address why one skilled in the art would be motivated to combine the automatic detection during the autofocusing operation of Terashita '643 with the detection during printing of Terashita '695. Further, for similar reasons, Applicants maintain that one skilled in the art would not be motivated to combine the teachings of Suzuki, namely, the touch panel 7 for identifying and performing a zoom operation, with the teachings of Terashita '643.

For the reasons set forth above, Applicants respectfully submit that the Examiner's rejections fail to establish prima facie obviousness under 35 U.S.C. §103 and, as such, it is respectfully requested that the outstanding rejections be withdrawn.

It is respectfully submitted that claims 2-5, 13-18, and 20-33 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1.

It is further respectfully submitted that claims 6 and 19 and new claims 36-38 contain elements similar to those discussed above

with regard to claim 1 and, thus, claims 34 and 35 are allowable over the references as cited by the Examiner.


**Conclusion**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Cathy M. Voisinet (Reg. 52,327) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.


Respectfully submitted,

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